

Appln. No.: 10/616,274
Petition Dated August 21, 2006

BSI-210US5



Appl. No: 10/616,274
Applicant: George Goicoechea et al.
Filed: 07/09/2003
Title: BIFURCATED ENDOLUMINAL PROSTHESIS
TC/A.U.: 3738
Examiner: Javier G Blanco
Confirmation No.: 1706
Docket No.: BSI-210US5

COPY

**PETITION FOR SUSPENSION OF ACTION FOR SIX MONTHS
FOR GOOD AND SUFFICIENT CAUSE PURSUANT TO 37 C.F.R. § 1.103(a)**

Mail Stop Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Applicants request the PTO to suspend action of this application for six months for good and sufficient cause pursuant to 37 C.F.R. § 1.103(a) for the following reasons.

Claims 54-73 are pending in this application and have been allowed. Claims 54-60 were substantially copied from U.S. Patent No. 6,416,542 which issued to Marcade et al. on July 9, 2002.

On February 22, 2006, the PTO informed Applicants that claims 54-73 had been allowed, invited Applicants to suggest an interference under 37 C.F.R. § 41.202(a), and closed prosecution on the merits in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Concurrently with the filing of the present Petition, Applicants have filed papers with the PTO that comply with the request to suggest an interference under 37 C.F.R. § 41.202(a). Applicants have also concurrently filed a Request for Continued Examination (RCE) along with an Information Disclosure Statement (IDS) and a request for suspension for three months pursuant to 37 C.F.R. § 1.103(c). The request for a three month suspension has been filed in case the present Petition for a six month suspension is denied. If this Petition is granted, Applicants request that the Order granting the Petition state the specific date when the six

month period (or whatever period is granted) will end in order to avoid any confusion that might result from the prior grant of a three month suspension pursuant to § 1.103(c).

The present application is a continuation application of Application No. 08/463,987, which is a division of Application No. 08/317,763, now U.S. Patent No. 5,609,627. On October 22, 2001, an assignment of the '627 patent to Scimed Life Systems, Inc. was recorded at reel/frame 012520/0229. An assignment recorded against an original application is applied to a division or continuation application. MPEP § 306. Therefore, the present application is currently assigned to Scimed Life Systems, Inc., a company that was renamed Boston Scientific Scimed, Inc. ("Boston Scientific").

The face of the Marcade '542 patent indicates that it is assigned to Endovascular Technologies, Inc. Endovascular Technologies, Inc. is a subsidiary of Guidant Corporation, and Guidant is the owner of the '542 patent. On April 21, 2006, Guidant merged with Boston Scientific. Since the Marcade '542 patent is now owned by Boston Scientific or its affiliates, a declaration of an interference may not be appropriate in accordance with 37 C.F.R. § 41.206 and MPEP 2304.05. According to the MPEP, after a merger of two corporations,

the resulting corporation owns both applications. The new corporation is obligated to investigate priority. Once the corporation has had an opportunity to determine which application is entitled to priority, the corporation must elect between the applications or otherwise eliminate the need for an interference.

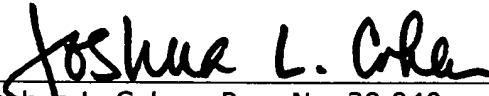
Boston Scientific has not yet been able to investigate priority between the present application and the Marcade '542 patent. The six month statutory deadline for response to the February 22, 2006 Office Action is August 22, 2006. Accordingly, Applicants request the PTO to suspend prosecution of this application for six months to enable Boston Scientific to investigate priority between the present application and the Marcade '542 patent.

Applicants submit that the above information provides good and sufficient cause for the PTO to suspend action in this application for six months, which action is requested. In addition to providing good and sufficient cause, Applicants have also

- Paid the fee required by 37 C.F.R. § 1.17(g) for the filing of this Petition;
- Submitted a reply to the outstanding Office Action by filing a suggestion for interference under 37 C.F.R. § 41.202(a);

- Paid the fee for a four month extension of time to respond to the outstanding Office Action

Respectfully submitted,



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SW/dhm

Dated: August 21, 2006

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The Director is hereby authorized to charge or credit Deposit Account No. 18-0350 for any additional fees, or any underpayment or credit for overpayment in connection herewith.

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail, with sufficient postage, in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on:

August 21, 2006

